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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/627,724      | 07/28/2003  | Timothy Effrem       | MAS001              | 3513             |

7590 04/04/2005  
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EXAMINER

TALBOT, MICHAEL

ART UNIT PAPER NUMBER

3722

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/627,724

Applicant(s)

EFFREM, TIMOTHY

Examiner

Michael W Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 15 and 19 are objected to because of the following informalities:

Regarding claim 15, insert a period --. at the end of the sentence following the word "above".

Regarding claim 19, delete the period "." between the text "24" and "mm" and replace with a space to read "24 mm."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 and 15-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims a shroud diameter of "25.5 mm to above". The claimed range is indefinite. Applicant's specification does not enable the claimed limitation.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "about" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase is part of the claimed invention. Furthermore, the phrase "about 25.5 mm to above" has an upper limit that is undefined. See MPEP § 2173.05(d).

Regarding claim 13, the phrase "a diameter in the range of about 40 mm to about 85 mm" is unclear as it is not supported by the specification. The range given was defined by the specification as the length of the second portion and not the diameter. For examination purposes, it is best understood that the phrase should have read "a diameter of about 25.2 mm to about 25.6 mm". Applicant is requested to cancel or amend the claim to include the desired limitation.

Regarding claims 14 and 18, the phrase "about" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase is part of the claimed invention. Furthermore, the phrase "about 5 mm to above" has an upper limit that is undefined. See MPEP § 2173.05(d).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman '716 in view of Lininger '228. Herman '716 shows in Figures 1-3 a handpiece used with flexible shaft assemblies (E) having a generally cylindrical shaped shroud (A,P,R) with a first end and a second end adapted to receive a connection device and a chuck assembly (J,L,M) which is rotatably connected (B,C,D) to the interior of the shroud. Herman '716 further shows a second portion of the shroud having a plurality of grooves/ridges and a plurality of jaws (page 1,

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line 76-80) for securing bit. Herman '716 lacks the first portion (A) of the shroud having a diameter between about 25.5 mm to above, or slightly greater than the outer diameter of the chuck. Lininger '228 shows in Figure 1 a tubular sleeve-like handle (14) covering the chuck (1) having a slightly larger diameter than the chuck. In view of this teaching of Lininger '228, it is considered to have been obvious to construct the shroud of Herman '716 with an inner diameter slightly larger than the outer diameter of the chuck as shown by Lininger '228 to provide a larger surface area for gripping the handpiece.

Alternatively, Herman '716 discloses the claimed invention except for the shroud diameter of first portion A. Lininger '228 teaches that it is known to construct a shroud/housing with a diameter slightly larger than the outer diameter of the chuck. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to construct a shroud/housing with an inner diameter slightly larger than the outer diameter of the chuck as taught by Lininger '228, since Lininger '228 shows this construction in Figure 1. Applicant has no criticality as to the diameter size of the shroud in relations to the chuck as per the submitted specification on page 5, lines 13-15.

Claims 1,7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman '716 in view of Taber '102. Herman '716 shows in Figures 1-3 a handpiece used with flexible shaft assemblies (E) having a generally cylindrical shaped shroud (A,P,R) with a first end and a second end adapted to receive a connection device and a chuck assembly (J,L,M) which is rotatably connected (B,C,D) to the interior of the shroud. Herman '716 further shows a second portion of the shroud having a plurality of grooves/ridges and a plurality of jaws (page 1, line 76-80) for securing bit. Herman '716 lacks the first portion (A) of the shroud having a diameter between about 25.5 mm to above, or slightly greater than the outer diameter of the chuck. Taber '102 shows in Figures 2,6 and 8 a generally cylindrical collar (20) covering the

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chuck (C) having a slightly larger diameter than the chuck (col. 5, lines 57-64 and col. 6, lines 57-66). In view of this teaching of Taber '102, it is considered to have been obvious to construct the shroud of Herman '716 with an inner diameter slightly larger than the outer diameter of the chuck as shown by Taber '102 to provide a larger surface area for gripping the handpiece.

Alternatively, Herman '716 discloses the claimed invention except for the shroud diameter of first portion A. Taber '102 teaches that it is known to construct a shroud/housing with an inner diameter slightly larger than the outer diameter of the chuck. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to construct a shroud/housing with a diameter slightly larger than the outer diameter of the chuck as taught by Taber '102, since Taber '102 show this construction in Figures 2, 6 and 8 and in col. 5, lines 57-64 and col. 6, lines 57-66. Applicant has no criticality as to the diameter size of the shroud in relations to the chuck as per the submitted specification on page 5, lines 13-15.

***Allowable Subject Matter***

5. Claims 2-6 and 8-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 13-19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

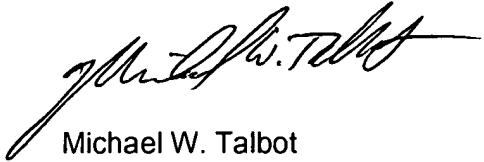
7. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Derris Banks, may be reached at 571-272-4419.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 703-872-9306.

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This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account.

Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot  
Examiner  
Art Unit 3722



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